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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Applicant: Edward R. Rhoads, et al.	§	Art Unit:	2185
Serial No.: 10/764,617	§	Examiner:	Zhuo H. Li
Filed: January 26, 2004	§	Atty Docket:	ITL.0241D1US (P7376D)
For: Organizing Information Stored in Non-Volatile Re-Programmable Semiconductor Memories	§	Assignee:	Intel Corporation

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

In response to the new arguments made by the Examiner, the following Reply Brief is submitted.

A. Are Claims 1-15 and 26-30 Unpatentable Over Claims 1-8 of Tallam (U.S. 6,948,099) on the Ground of Non-Statutory Obviousness Type Double Patenting?

The only thing new in the Examiner's arguments is continuing reliance on the specification of the cited references instead of the claims. This is improper. For all the reasons set forth in the appeal brief, the rejection should be reversed.

B. Are Claims 1-15 and 26-30 Anticipated Under 35 U.S.C. § 102(e) by Tallam (U.S.6,948,099)?

For the first time on appeal, the Examiner cites the decision in *In re Mathews,* 408 F.2d 1393, 161 U.S.P.Q. 276 (C.C.P.A. 1969). While the case is cited for the proposition that the

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inventor of the pending application must show that he invented the claimed subject matter, the case actually holds the exact opposite.

In that case, there was an earlier application to Dewey and a later application to Mathews. The Dewey application incorporated material from the Mathews application. Instead of providing an affidavit from Mathews saying that Mathews invented first, an affidavit from Dewey was provided. The Board said that Dewey was good enough, indicating that:

> Consistent with the Milburn "rule" we agree that the Dewey patent "indicates" *prima facie* evidence that Mathews was not the first inventor. But, here, unlike Milburn, there is further evidence, uncontroverted by the Patent Office, that Mathews was not only the first inventor, but also the only inventor, so far as the record shows. Dewey's affidavit and Matthew's oath accompanying his application are sufficient, we feel, to prove that the relevant disclosure in Dewey was a disclosure of Matthew's invention.

In re Mathews, 161 U.S.P.Q. 278, 279 (C.C.P.A. 1969).

If this were not enough, the C.C.P.A. went on to say that:

> The Patent Office contention that Appellant must comply with Rule 131 is not persuasive since we have already pointed out in *In re Land, supra*, that a Rule 131 affidavit is not the only way of antedating a reference. The solicitor has cited no precedent in support of his position that a reference patent may only be antedated by a Rule 131 affidavit .... So far as we have been advised, there is no such precedent to the effect that a Rule 131 affidavit is the only way to overcome a reference cited to evidence lack of novelty.

In re Mathews, 161 U.S.P.Q. at 279.

Here, the exact same type of evidence supports the reversal of a rejection. Here, we have Trop's Declaration saying that he used information from Rhoads et al. in Tallam's application. Thus, we have the Declaration of the only person who would know, the prosecuting attorney, that he used the material from the second filed application in the first application. The Patent Office has no rebuttal of this evidence and, therefore, the maintenance of the rejection is improper.

Therefore, the rejection should be reversed.

C. Are Claims 1-15 and 26-30 Anticipated Under 35 U.S.C. § 102(b) by Bunnell (U.S. 5,594,903?

The reasoning with respect to the maintenance of the rejection based on Bunnell, set forth beginning on page 14, is not clear. It seems to start with the proposition that the memory portion 62, clearly labeled as a ROM, is a non-volatile reprogrammable semiconductor memory. However, the cited material in the specification clearly confirms that this is not the case.

Namely, column 7, lines 47-50, states "The address space portion 60 includes a non-volatile portion 62, preferably implemented through any one of a combination of ROM, EPROM, EEPROM, and flash EPROM storage devices." Plainly, given the provision of the comma after 62 in the above quote, what is being referred to in the list of memory claims is the address space portion 60 (which is a virtual address space). See column 7, line 41. Particularly, if the language "preferably implemented through" refers to the non-volatile portion 62, there would be no reason for the provision of a comma after 62. This virtual address space corresponds to both RAM and ROM memory, as depicted in Figure 3.

The portion 62 is specifically ROM, as demonstrated in Figure 3. But other parts, as labeled in Figure 3, include RAM.

Thus, the text in column 7 indicates that the entire portion 60 may include RAM and ROM (as depicted in FIgure 3) in virtual memory, but, clearly, the portion 62 alone is ROM, as depicted in Figure 3.

There would be no reason to implement the ROM by a combination of ROM and RAM or to implement the RAM by a combination of ROM or RAM. Thus, the only reasonable interpretation of the language, consistent with Figure 3, is that it is the address space portion 60, which may include ROM, EPROM, EEPROM, and flash EPROM storage devices, includes ROM and RAM.

Moreover, the portion 62 includes ROM disk 76, as indicated in Figure 3. It is impossible that the portion 62 could really be RAM.

The rest of the rejection continues to rely on the assertion that the portion 62, plainly labeled as ROM, is really RAM, and is erroneous for at least this reason.

Respectfully submitted,

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